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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,268	10/20/2004	Shuji Hahakura	040256-0135	6578
23392 7590 01/09/2009 FOLEY & LARDNER 2029 CENTURY PARK EAST SUITE 3500 LOS ANGELES, CA 90067			EXAMINER TALBOT, BRIAN K	
			ART UNIT 1792	PAPER NUMBER
			MAIL DATE 01/09/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,268

Applicant(s)

HAHAKURA ET AL.

Examiner

Brian K. Talbot

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,7 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,16,18 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 2,7,17 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/08 has been entered.
2. The non-entered amendment filed 10/14/08 has been considered and entered per filing an RCE. Claims 3-5 and 8-15 have been canceled. Claims 21-22 have been added. Claims 1,2,6,7 and 16-22 remain in the application.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. In light of the amendment and response filed 11/14/08, the 35 USC 112 rejection has been withdrawn along with the 35 USC 103 rejection, however the following rejection has been necessitated by the amendment.

Claim Rejections - 35 USC § 103

5. Claims 1,6,16,18, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 04-212,214 in combination with Tauber et al. (6,275,716).

JP 04-212,214 teaches a laser deposition process in which the deposition rate is set low during the initial stage and increased thereafter (abstract). The examples include a laser frequency of 1 Hz and a second laser frequency of 100Hz.

JP 04-212,214 fails to teach the claimed power, substrate temperature, gas pressure and atmosphere.

Tauber et al. (6,275,716) teaches high critical temperature superconductors formed by PLD having process parameters being laser repetition rate of 10 Hz, laser power/fluence of 1-2 J, oxygen pressure of 13.6 Pa with a substrate temperature of 850°C (abstract and col. 3, line 60 – col. 4, line 18).

Therefore it would have been obvious for one skilled in the art at the time the invention was made to have modified JP 04-212,214 PLD superconducting process to include the processing parameters as evidenced by Tauber et al. (6,275,716) with the expectation of achieving similar success as well as a high critical temperature superconductor.

Furthermore, it is well settled that determination of optimum values of cause effective variables such as these process parameters is within the skill of one practicing in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980). It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable through routine experimentation in the absence of a showing of criticality. *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). It would have been obvious to one having ordinary skill in the art to have determined the optimum values of the relevant process parameters through routine experimentation in the absence of a showing of criticality. *In re Aller*, USPQ 233 (CCPA 1955).

Allowable Subject Matter

6. Claims 2,7,17 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Reasons for Allowance

7. The following is an examiner's statement of reasons for allowance:

The prior art of record while teaching a first laser frequency of 1 MHZ and a second laser frequency of 100 MHZ fails to teach or fairly suggest the first and second laser frequencies to those required by the claim which results in improved critical current density as supported by the

specification. The prior art teaches a lower current density with the second frequency being 100 times that of the first.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Amendment

8. Applicant's arguments with respect to claims 1,2,6,16,18,20-22 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argued that the prior art failed to teach the processing parameters of laser power, gas pressure, substrate temperature and oxygen atmosphere as now claimed.

The Examiner disagrees. As noted above, Tauber et al. (6,275,716) teaches these processing parameters and advantages garnered therefrom.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Talbot whose telephone number is (571) 272-1428. The examiner can normally be reached on Monday-Friday 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian K Talbot/
Primary Examiner, Art Unit 1792

BKT

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